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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN A. SWARTZ IV

Appeal 2014-006779¹
Application 11/740,814²
Technology Center 3600

Before MURRIEL E. CRAWFORD, KENNETH G. SCHOPFER, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1, 6, 11, 12, 14, 29–32, and 36–46.³ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ Throughout this opinion, we refer to the Appellant's Appeal Brief ("Appeal Br.," filed Dec. 31, 2013), Reply Brief ("Reply Br.," filed May 28, 2014), and Specification ("Spec.," filed Apr. 26, 2007), and to the Examiner's Answer ("Ans.," mailed Mar. 28, 2014) and Final Office Action ("Final Act.," mailed July 31, 2013).

² According to the Appellant, the real party in interest is "Illinois Tool Works Inc., the assignee." Appeal Br. 2.

³ Claims 17, 19, 22, 25, 33, and 34 are indicated as allowed (Final Act. 13) and, thus, are not pending in this Appeal.

STATEMENT OF THE CASE

The Appellant's invention relates "generally to a welding garment. More specifically, the invention relates to a flame-resistant welding garment, such as a welding jacket or another article of clothing, configured to receive a supplemental flame-resistant protective layer or other accessory attachments." Spec. ¶ 2.

Claims 1, 11, and 17 are the independent claims on appeal. Claims 1 and 11 (Appeal Br. 15, 16 (Claims App.)), reproduced below, are illustrative of the subject matter on appeal:

1. A welding garment, comprising:

an article of clothing comprising a first layer of a first flame-resistant material and a fastening mechanism positioned at a mid-portion of the article of clothing; and

a second layer of a second flame-resistant material, wherein the second layer of the second flame-resistant material comprises an attachment mechanism, wherein the second layer of the second flame-resistant material is configured to be removably attached to an exterior surface of the article of clothing via engagement of the attachment mechanism with the fastening mechanism, wherein the fastening mechanism and the attachment mechanism are covered by a flap of the first flame-resistant material positioned at the mid-portion of the article of clothing, the article of clothing is configured to removably receive the second layer of the second flame-resistant material at least substantially over the first layer of the first flame-resistant material via the fastening mechanism, and the second flame-resistant material comprises a base material impregnated with a flame-retardant chemical.

11. A garment, comprising:

a welding jacket that completely covers a front and a back of a torso of a wearer when worn by the wearer; and

a protective layer of clothing comprising a first flame-resistant material and a fastening mechanism configured to be removably attached to a surface of the welding jacket at different positions to cover different portions of the welding jacket and the torso of the wearer; wherein the first flame-resistant material comprises a base material impregnated with a flame-retardant chemical, and the different portions are partially overlapping and partially offset from one another.

REJECTIONS⁴

Claims 11, 12, 14, 31, 32, and 43–46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grilliot (US 4,999,850, iss. Mar. 19, 1991) and Silver (US 2007/0094763 A1, pub. May 3, 2007). Final Act. 3.

Claims 1, 6, 29, 30, and 36–42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Silver and Buckler (US 1,068,976, iss. July 29, 1913). *Id.* at 7.

FINDINGS OF FACT

The findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.

ANALYSIS

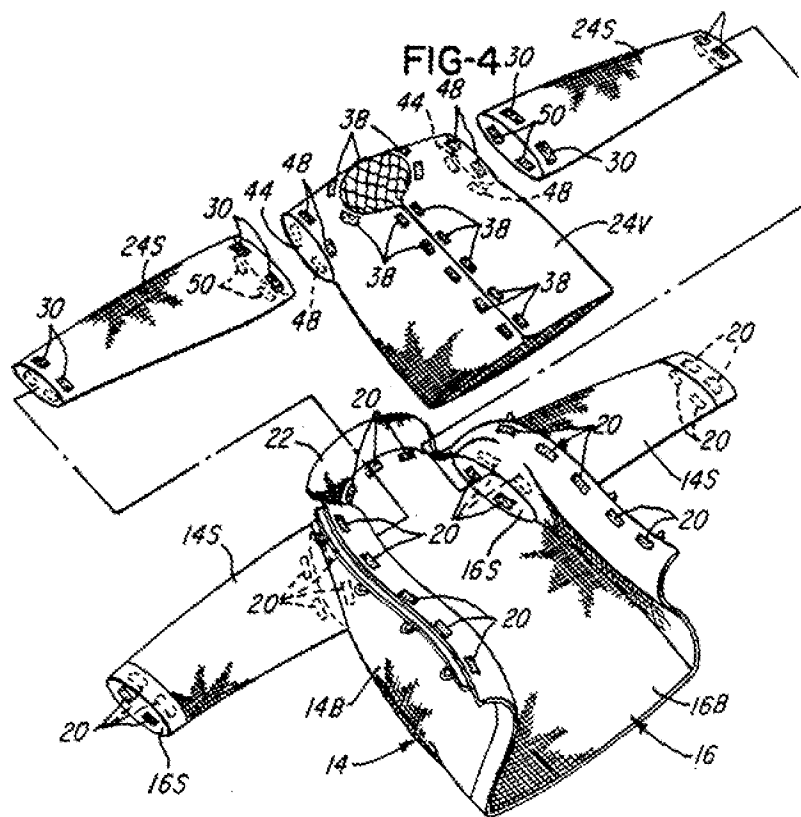
Claims 11, 12, 14, 31, 32, and 43–46

The Appellant contends that the Examiner’s rejection of independent claim 11 is in error because “Grilliot and Silver fail to teach or suggest a protective layer of clothing with a fastening mechanism configured to be

⁴ The rejections are addressed in the order presented by the Examiner and argued by the Appellant.

removably attached to a surface of the welding jacket at different positions to cover different portions of a welding jacket and a torso of the wearer, as generally recited by independent claim 11.” Appeal Br. 7.⁵ Specifically, the Appellant argues that Grilliot’s “bunker coat 12 that may be worn over a vest section 24V in only one position, where attachment elements 20 of the bunker coat 12 attach to complementary attachment elements 38 of the vest section 24V.” *Id.*

Figure 4 showing Grilliot’s garment is reproduced below.



⁵ We note that the Appellant argues that the rejection “is improper because the rejection fails to establish a prima facie case of anticipation.” Appeal Br. 7 (emphases omitted). We note that the rejection is one of obviousness. We consider the inclusion of the term “anticipation” as inadvertent error, and, thus, consider the argument in reference to obviousness.

Figure 4 shows “a perspective exploded view of [a] firefighter’s bunker coat... illustrating the structure and method of attachment of the thermal protective sections to other portions of the firefighter’s bunker coat.” Grilliot col. 3, ll. 40–44.

The Examiner relies on Grilliot for disclosing an outer shell 14 and a thermal barrier 24 comprising a fastening mechanism 38 configured as claimed. Final Act. 3–4. Specifically, the Examiner finds “the fasteners 38 can be attached at different locations along fasteners 20 at different heights thus covering different areas of the wearer; wherein the bottom fastener 38 along the central opening of layer 24V can be attached to a fastener other than the one at the bottom of fasteners 20 on coat 14 thus covering different areas.” *Id.* at 4. The Examiner further appears to find that the limitation “configured to be removably attached” is an intended use that does not result in a structural difference, and the fasteners being capable of being repositioned meets the claimed limitation. *See* Ans. 2–3.

As an initial matter, we note that although the Examiner applies a broad meaning to the phrase “configured to” to mean “capable of” (Ans. 3), we find the ordinary and customary meaning of this phrase, especially in light of the Appellant’s Specification, supports a narrower meaning for this phrase to require that the protective layer of clothing with the fastening element is designed to the particular use, purpose or situation. *See Aspec Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012) (The phrase “adapted to” construed narrowly to mean “configured to”, as opposed to “capable of” or “having the capacity to”); *Typhoon Touch Technologies, Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (construing “memory ... configured to” as “memory that must perform the

recited function”); *Boston Scientific Corp. v. Cordis Corp.*, 2006 WL 3782840 (N.D. CA. 2006) (“A widely accepted dictionary definition of the word ‘configure’ means ‘[t]o design, arrange, set up, or shape with a view to specific applications or uses.’ American Heritage Dictionary 386 (4th ed. 2000).”). The broadest reasonable interpretation in light of the Specification of the limitations is that the protective layer of clothing having fastening elements is removably attached to a surface of the jacket at different positions covering different portions of the jacket and torso. This interpretation is supported/bolstered by the Specification which discloses the layer of clothing being attached in an upper area to cover the torso as a bib, in a lower area to cover the waist area, or in other combinations. Spec. ¶¶ 30, 31.

Grilliot discloses a coat 12 with an outer shell 14 and moisture barrier layer 16, within which is thermal barrier layer 24. Grilliot, col. 4, ll. 25–27, 49–51, Fig. 4 (reproduced above). The thermal barrier layer 24 comprises sleeve sections 24S to which attachment elements 30 are secured for attaching the sleeves to the attachment elements 20 within the sleeve parts 16S of the moisture barrier layer 16, and a vest section 24V to which attachment elements 38 are secured for attaching the vest to attachment elements 20 secured to the moisture barrier layer 16. *Id.* at col. 4, l. 49–5, l. 1. The vest section 24V has arm openings 44 with attachment elements 48 such that the sleeve sections 24S of the thermal barrier layer are releasably attached to the vest section 24V. *Id.* at col. 5, ll. 1–8.

Thus, Grilliot discloses protective layers of clothing in the form of a vest element and sleeve elements. The protective layers have a fastening mechanism configured to removably attach to a surface of the welding

jacket. However, Grilliot depicts that sleeve elements attach only in one position, i.e., elements 30 attach to sleeve element 20, and the vest element attaches only in one position, lining up elements 38 with their corresponding elements 20. Because of the shape of the vest that includes a collar, we find persuasive the Appellant's argument that the Examiner's finding (Final Act. 3) that Grilliot's fasteners 38 can be attached at different locations along fasteners 20 at different heights covering different area is in error. *See* Appeal Br. 7–8. Therefore, we agree that Grilliot, relied upon by the Examiner, does not disclose the layer of clothing with a fastening mechanism configured to be removably attached to a surface of the jacket at different positions covering different portions of the jacket and torso.

Based on the foregoing, we do not sustain the Examiner's rejection of independent claim 11 and its dependent claims 12, 14, 31, 32, and 43–46 that rely on the same inadequate finding.

Claims 1, 6, 29, 30, and 36–42

The Appellant contends that the Examiner's rejection of independent claim 1 is in error because “[t]he cited references, taken alone or in hypothetical combination, do not appear to teach or suggest an article of clothing having a flap positioned at the mid-portion of the article of clothing, as generally recited by independent claim 1.” Appeal Br. 12. Specifically, the Appellant argues that the Examiner relies on Buckler that teaches “attachment of a skirt 3 to the inside bottom of a jersey 2 so that a lower edge 4 of the jersey 2 overhangs the top of the skirt 3 . . . [so as] to cover the body above the wearer's hips, and the skirt 3 is to extend below the wearer's hips,” rather than a flap positioned at a mid-portion as claimed. *Id.*

We are not persuaded by the Appellant's argument that the references do not teach the contested limitation. We first note that the Appellant argues against each reference individually when the Examiner relies on the combination to disclose the limitation. The Examiner relies on Silver for disclosing fasteners being at a mid-portion of the clothing and on Buckler for disclosing a flap to cover the fasteners. *See* Final Act. 7–8 (citing Silver Fig. 2 “30”, and Buckler, 1, 2, Fig. 6), Ans. 8. The test for obviousness is not what any one reference would have suggested, but rather what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

Silver at Figure 2 discloses fastener elements 52 at a position above the knee, between the top and bottom of the pants garment. The Specification does not provide a definition as to what would be considered the “mid-portion” of the garment, but does discuss flap 32 located at the first bottom edge 28 that can be “lifted to expose the fastening mechanism thereby enabling bib 42 to be removably attached to jacket 10.” Spec. ¶¶ 28, 31. Thus, giving the term its broadest reasonable interpretation in light of the Specification (*see In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)), we construe “mid-portion” to comprise any portion between the top and bottom of the garment. As such, we agree with the Examiner's finding that Silver's fastener elements are at a position that is at a “mid-portion” of the garment.

Buckler discloses a double welt on the edge of the garment covering and concealing the attachment elements of buttons, snap fasteners, or other readily releasable device, for securing two garments. *See* Buckler, col. 2, ll. 4–22, 43–46. As such, we agree with the Examiner's finding that Buckler

discloses a flap over a set of external fasteners and further find adequate support for the Examiner's finding that one would modify Silver with Buckler "so as to hide the fasteners from view and give the garment a clean and neat appearance." Final Act. 8.

We further find unpersuasive the Appellant's argument that the combination of the references "teach difference principles of operation." Appeal Br. 12–13. To the extent the Appellant argues that Buckler teaches away from Silver because the proposed modification would change the basic principle of operation of Silver, we disagree. We note that the Examiner's rejection is not based on the bodily incorporation of Buckler with Silver. Rather, the Examiner, as noted above, relies of Buckler for modifying Silver to have a fold, i.e., flap, in the leg portion that would cover the fastener elements. The Appellant does not adequately show how a fold would change the basic principle of operation of Silver of connecting the leg shells over an exterior of the pant leg.

Based on the foregoing, we sustain the Examiner's rejection of claim 1. We also sustain the rejection of dependent claims 6, 29, 30, and 36–42, not argued separately. *See* Appeal Br. 13.

DECISION

The Examiner's rejection of claims 11, 12, 14, 31, 32, and 43–46 under 35 U.S.C. § 103(a) is REVERSED.

The Examiner's rejection of claims 1, 6, 29, 30, and 36–42 under 35 U.S.C. § 103(a) is AFFIRMED.

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No time period of taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART